REMARKS/ARGUMENTS

Claims 1-13 stand rejected in the outstanding Official Action. Claims 1-13 are not amended and therefore remain in the application.

On page 2 of the outstanding Official Action, the Examiner suggests that the title be changed to read "Test Bit-stream Generator and Method for Decoders" and this suggestion has been adopted in the above amendment.

With respect to objections to the drawings, the Examiner also suggests that applicant remove the parenthesis in Figure 1, block 130. Applicant encloses herewith a proposed drawing correction removing the parenthesis in accordance with the Examiner's suggestion.

The Examiner suggests that in Figure 2, block 210 should be separated into three blocks. This suggestion is believed not to be correct. Applicant's invention of initializing the bitstream comprises the steps of choosing an interesting image size and entry point and the setting of defaults (see page 8, lines 26-31 of applicant's specification). Applicant's Figure 2 correctly shows that these steps are accomplished at one point in the program sequence as shown, and this appears to be correct. How or why the Examiner believes Figure 2, and in particular block 210, is improper or inconsistent with applicant's specification or why this block is not believed to contain the appropriate enabling disclosure of the invention is not understood and clarification is requested.

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The Examiner also objects to Figure 2 as allegedly lacking "an exit condition or strategy." Again, the Examiner's objection is not understood, as block 230 is clearly the exit, and applicant's specification at page 9, lines 3 and 4 indicates that once it has been determined that the end of the syntax has been reached, the process terminates at step 230. How or why the Examiner believes Figure 2 lacks an exit condition or strategy is not understood and clarification is requested.

Finally, the Examiner's comments relating to Figure 4 are not understood at all. The Examiner is respectfully requested to point out what MPEP provision or rule is not complied with in Figure 4. The blocks are believed to be properly labeled and identified, and how or why the Examiner objects to Figure 4 is not understood. Clarification is respectfully requested.

Claims 1-13 stand rejected under 35 USC §102 as anticipated by Panaro (U.S. Patent 5,731,839). It is noted that Panaro relates to a technique for testing bitstream decoders (see the Abstract). In Panaro, a bitstream is provided and applied to a decoder under test as described at column 3, lines 18-22. The test bitstreams are predefined and recalled from memory when required for testing as described at column 3, lines 32-34. As Panaro discusses in column 4, beginning at line 45, his bitstream generation routine is executed on a general purpose computer, but the test bitstream itself is typically created manually as disclosed at column 4, lines 55-57. As a result, Panaro is essentially just one example of the prior art already acknowledged in applicant's specification as originally filed (see page 1, lines 19-26).

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Applicant's independent claim 1 requires the first step of "generating test code from the syntax" where syntax has been defined as "a predefined syntax." The generating step also specifies that "the test code being arranged when executed to generate a test bitstream dependent on values assigned to a plurality of variables, each variable having a number of interesting values."

The Examiner suggests that the above portion of claim 1 is disclosed in Panaro at column 2, lines 20-45, which describes the creation of a sequence of images in Panaro for coding using a predictive coder. However, there is no analogous step in Panaro to applicant's claim 1 in which a test bitstream is generated from executed test code, which itself is generated from a predefined syntax.

At best, the bitstream generation in Panaro (generation routine 200) is disclosed which assists in the generation of test bitstreams (as confirmed in Panaro at column 4, lines 45-47). There is no teaching in Panaro that the bitstream generation routine 200 is itself generated as part of the method of generating test streams or that the bitstream generation routine 200 is generated from predefined syntax as required by claim 1. Simply put, Panaro does not perform applicant's claimed step (a), nor has the Examiner pointed out how or where he or she believes this to be disclosed in Panaro.

Claim 1 also requires the second step of "executing the test code" and in that regard states "for each of said variables, assigning that variable one of its interesting values." According to column 3, line 50 through column 4, line 37, Panaro does not

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disclose the use of variables (or interesting values) or assigning values to such variables as required by claim 1. The cited portion of Panaro simply provides more details on the arrangement of the frames used to test the decoder.

The Court of Appeals for the Federal Circuit has noted in the case of *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984) that "[a]nticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Because Panaro, even the portions as cited by the Examiner in the rejection, does not teach applicant's method steps set out in independent claim 1, it clearly does not teach the steps set out in dependent claims 2-10. Applicant's independent apparatus claim 11 also specifies structure which performs these various steps set forth in claim 1, and as a result, Panaro, because it doesn't teach the steps, certainly cannot teach structure for performing those steps. As a result, there is no support for any rejection of claims 1-13 under 35 USC §102 (or even under §103) in view of the Panaro reference. Accordingly, reconsideration of the Examiner's rejection under 35 USC §102 is respectfully requested.
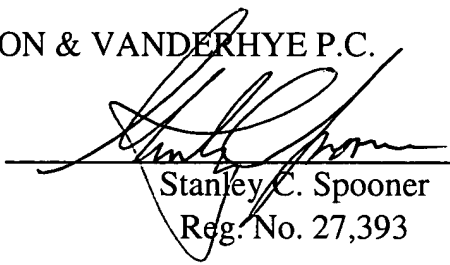
Having responded to all objections and rejections set forth in the outstanding Official Action, it is submitted that claims 1-13 are in condition for allowance and notice to that effect is respectfully solicited. In the event the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he or she is respectfully requested to contact applicant's undersigned representative.

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Respectfully submitted,

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